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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,501	03/16/2001	Giles Henry Rodway	RK590-US1	3959

7590 08/12/2005

Marguerite E Gerstner
Raychem Corporation
300 Constitution Drive
MS 120 6600
Menlo Park, CA 94025-1164

EXAMINER

KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,501

Applicant(s)

RODWAY

Examiner

Kevin R. Kruer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-33, 37-43, 46-54, 57-71, 74 and 75 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 28-33, 37-43, 46-54, 57-71, 74 and 75 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

The finality of the Office Action mailed May 17, 2005 has been removed. The amendment filed July 21, 2005 has been entered.

The examiner notes that the claim appendix filed July 21, 2005 contains two claims number "claim 74." The latter of said claims is referred to herein as claim 75.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 33, 60, 61, and 64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language of the independent claims has been "closed" causing claims 33, 60, 61, and 64 to be indefinite. This rejection can be overcome as follows:

In claims 33 and 61, the word "composition" should be changed to "portion" or "comprising" should be changed to "consisting."

In claim 64, the word "composition" should be changed to "portion."

In claim 60, the phrase "polymeric composition comprises" should be deleted.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 28-33, 37-43, 46-54, 57-71, 74, and 75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. US 6,753,478. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter of US'478 encompasses the species claimed in the pending application.

Specifically, US'478 claims:

An electrical wire or cable having insulation comprising

(I) a first layer which is composed of a first polymeric composition consisting of a first polymeric component and optionally a first non-polymeric component, the first polymeric component comprising at least 20% by weight, based on the weight of the first polymeric component, of a carbonyl-containing polymer comprising at least 5% by weight, based on the weight of the carbonyl-containing polymer, of repeating units derived from a monomer which can be copolymerized with an olefinic monomer and which contains a carboxylic acid ester group; and

(II) a second layer which is in direct contact with the first layer at an interface, and which is composed of a second polymeric composition consisting of a second polymeric component and optionally a second non-polymeric component, the second polymeric component comprising at least 10% by weight, based on the weight of second polymeric composition, of a fluoropolymer, and being free of polymers containing more than 50% by weight, based on the weight of the polymer, of repeating units derived from vinylidene fluoride.

Claim Rejections - 35 USC § 102

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(f) he did not himself invent the subject matter sought to be patented.

6. Claims 28-33, 37-43, 46-54, 57-71, 74, and 75 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Specifically, US 6,753,478 (to a different inventive entity than the pending application) teaches the following:

An electrical wire or cable having insulation comprising

(I) a first layer which is composed of a first polymeric composition consisting of a first polymeric component and optionally a first non-polymeric component, the first polymeric component comprising at least 20% by weight, based on the weight of the first polymeric component, of a carbonyl-containing polymer comprising at least 5% by weight, based on the weight of the carbonyl-containing polymer, of repeating units derived from a monomer which can be copolymerized with an olefinic monomer and which contains a carboxylic acid ester group; and

(II) a second layer which is in direct contact with the first layer at an interface, and which is composed of a second polymeric composition consisting of a second polymeric component and optionally a second non-polymeric component, the second polymeric component comprising at least 10% by weight, based on the weight of second polymeric composition, of a fluoropolymer, and being free of polymers containing more than 50% by weight, based on the weight of the polymer, of repeating units derived from vinylidene fluoride.

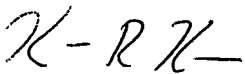
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "K-R K", with a horizontal line extending from the end.

Kevin R. Kruer
Patent Examiner-Art Unit 1773